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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,340	11/20/2003	Rory F. Finn	01449/1	3646
45734	7590	12/05/2006	EXAMINER	
SENNIGER POWERS (PHA) ONE METROPOLITAN SQUARE 16TH FLOOR ST. LOUIS, MO 63102			AUDET, MAURY A	
			ART UNIT	PAPER NUMBER
			1654	

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/718,340	FINN, RORY F.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Maury Audet	1654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 18 September 2006.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 and 16-20 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-9 and 15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 20 November 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/06 and 08/05.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of Group I, claims 1-9 and 15, and the species m=3, n=4, and R=human growth hormone, in the reply filed on 09/18/2006 is acknowledged. The traversal is on the ground(s) that it would not be a serious burden to search Groups I and II. This is not found persuasive for the reasons of record. However, should allowable subject matter be found in the Group I conjugate/composition, then Group II may be considered for rejoinder under *In re Ochiai*, if narrowed to the identical scope. Claims 10-14 and 16-20 are withdrawn from consideration as being drawn to non-elected subject matter. Claims 1-9 and 15 are examined on the merits as being drawn to the elected invention, and the species m=3, n=4, and R=human growth hormone.

The requirement is still deemed proper and is therefore made FINAL.

### *Claim Rejections - 35 USC § 112 1<sup>st</sup> Written Description*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 and 15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a "written description" rejection, rather than an enablement rejection under 35 U.S.C. 112, first paragraph. Applicant is directed to the

Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No. 4, pages 1099-1111, Friday January 5, 2001.

*Vas-Cath Inc. V. Mahurka*, 19 USPQ2d 1111, states that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention, for purposes of the "written description" inquiry, is *whatever is now claimed*" (see page 1117).

The claimed invention is drawn to a PEG-linking structure-HGH conjugate and composition thereof.

One of skill in the art would not recognize from the disclosure that the Applicant was in possession of the claimed genus of PEG-linking structure-HGH, wherein the linking structure may be bound at any point to either PEG or HGH. Applicant's does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed" (see *Vas-Cath* at page 1116). Namely, although the specification, at e.g. page 20, as directed by Applicant in the response to the restriction requirement, provides general points of binding the compounds PEG and HGH, a complete conjugated structure as contemplated is lacking in the claims, and arguably in the specification. Absent a complete structure in the claims, a reasonable search could not be conducted, nor would one of skill in the art be apprised of the invention and whether or not other variants read thereon. Thus, neither the claims nor the specification adequately describe the claimed genus of the linking structure bound anywhere to PEG or HGH, in order to carry out the invention. One of skill in the art would not recognize from the

disclosure that the Applicant was in possession of the genus, namely PEG-linking structure-HGH, wherein the linking structure may be bound at any point to either PEG or HGH.

***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached on M-Th. 7AM-5:30PM (10 Hrs.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA, 11/25/2006

MAURY AUDET  
PATENT EXAMINER

